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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,095	01/26/2001	David Konetski	16356.578 (DC-02701)	7695
27683	7590	09/20/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			DALENCOURT, YVES	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/771,095

**Applicant(s)**

KONETSKI ET AL.

**Examiner**

Yves Dalencourt

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-24, and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All. b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is responsive to amendment filed on 06/29/05.

#### ***Response to Amendment***

The examiner has acknowledged the amended claims 1 and 15.

#### ***Response to Arguments***

Applicant's arguments filed on 06/29/05 have been fully considered but they are not persuasive.

Applicants argue that the combination of the references fails to teach or suggest, performing processing functions that may otherwise be handled by a thin media client on the digital media content, wherein the functions vary according to a type of the digital media content and are capable of being performed during and after the digital media content is downloaded (page 8, fifth paragraph). However, the examiner maintains that Lai does teach such limitation (see paragraphs [0087], [0141], [0158 – 0159], and [0188 – 0191]. Lai discloses that the viewer client 102 is a personal computer that includes a Web browser and one or more media players running under the computer operating system. Alternatively, the viewer client 102 can be a WEBTV, a WINDOWS CE device, a Personal Digital Assistant (PDA), and so on. Lai also discloses the downloading may be fully performed prior to viewing or it may be progressive. That is a portion of the transcode media content may be downloaded and then viewed, while a second portion of the media content is being downloaded).

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In response to Applicant's arguments, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971

It has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969).

In view of such, the rejection is sustained and repeated as follow:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 – 10, 12 – 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomi et al (US 6,769,127; hereinafter Bonomi) in view of Lai et al (US 20040193648; hereinafter Lai).

Regarding claims 1, 12, and 14, Bonomi teaches a system (fig. 1A) comprising a computer system including a processor and a memory (100, fig. 1A; col. 6, lines 52 – 57; col. 7, lines 10 - 26) for retrieving digital media content (col. 9, lines 35 - 38); temporarily storing the digital media content in the memory for various lengths of time (col. 7, lines 44 – 62; col. 9, lines 5 – 35 and 38 – 40; Bonomi discloses that to efficiently use the media storage 220, the recording space 230 is storing such programs for a limited time); buffering the digital media content (col. 9, lines 15 – 18 and 50 – 57; Bonomi discloses that the cache area 222 provides a mechanism to buffer the received live video broadcasts); and providing the digital media content as needed via a user interface to a thin media client using a first network (162 and 164; fig.1B; paragraph bridging col. 9, line 57 through col. 10, line 3 and figs. 15A-15F; col. 32, lines 55 - 67).

Bonomi teaches substantially all the limitations, but fails to specifically teach performing processing functions on the digital media content which vary according to a

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type of digital media content, the functions being able to be performed during and after the digital media content is downloaded.

However, Lai teaches, in the same field of endeavor, a distributed on-demand media transcoding system and method, which performs processing functions on the digital media content which vary according to a type of digital media content, the functions being able to be performed during and after the digital media content is downloaded (fig. 5A; paragraphs [0141], [0158 - 0159], and [0188 - 0191]; Lai discloses the downloading may be fully performed prior to viewing or it may be progressive. That is a portion of the transcode media content may be downloaded and then viewed, while a second portion of the media content is being downloaded).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Bonomi by performing processing functions on the digital media content which vary according to a type of digital media content, the functions being able to be performed during and after the digital media content is downloaded as evidenced by Lai for the purpose permitting content providers to deliver media content to users with media players incapable of accommodating the source type of the original media content, thereby, obviating the need for a user to download a newer media player or upgrade an existing media player in order to access a desired media content.

Regarding claims 2 and 3, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the thin media client comprises an audio client; and wherein the digital media content comprises an audio file (col. 7, lines 33 - 62).

Regarding claim 4, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the digital media content comprises realtime audio information (col. 8, lines 35 - 54).

Regarding claims 5 and 6, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the thin media client comprises a video client, and wherein the digital media content comprises video information; and wherein the thin media client comprises an image client, and wherein the digital media content comprises image information (fig. 1B; col. 1, lines 30 – 36; col. 5, lines 32 – 40; col. 7, lines 33 – 50).

Regarding claim 7, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the computer system is for transcoding the digital media content prior to providing the digital media content to the thin media client (305, fig. 3A; col. 6, lines 45 – 57; col. 11, lines 26 - 50).

Regarding claim 8, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the computer system is for performing a rights management task associated with the digital media content prior to providing the digital media content to the thin media client (col. 15, lines 19 - 54).

Regarding claim 9, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the computer system is for performing a decompression function on the digital media content prior to providing the digital media content to the thin media client (paragraph bridging col. 12, line 59 through col. 13, line 14).



Regarding claim 10, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the computer system is for performing a decryption function on the digital media content prior to providing the digital media content to the thin media client (col. 14, lines 53 – 62; paragraph bridging col. 14, line 63 through col. 15, line 7).

Regarding claim 13, Bonomi and Lai teach all the limitations, and Bonomi further teaches a system, wherein the computer system is for retrieving the digital media content using a second network (col. 7, lines 10 – 32; Bonomi discloses that the network 108 can be part of a larger network including the Internet, the public switch telephone network (PSTN) or a private telephone network and so on).

Regarding claims 15 and 26, Bonomi teaches a method (fig. 1A) comprising a computer system including a processor and a memory (100, fig. 1A; col. 6, lines 52 – 57; col. 7, lines 10 - 26) for retrieving digital media content (col. 9, lines 35 - 38); temporarily storing the digital media content in the memory for various lengths of time (col. 7, lines 44 – 62; col. 9, lines 5 – 35 and 38 – 40; Bonomi discloses that to efficiently use the media storage 220, the recording space 230 is storing such programs for a limited time); buffering the digital media content (col. 9, lines 15 – 18 and 50 – 57; Bonomi discloses that the cache area 222 provides a mechanism to buffer the received live video broadcasts); and providing the digital media content as needed via a user interface to a thin media client using a first network (162 and 164; fig.1B; paragraph bridging col. 9, line 57 through col. 10, line 3 and figs. 15A-15F; col. 32, lines 55 - 67).

Bonomi teaches substantially all the limitations, but fails to specifically teach performing processing functions on the digital media content which vary according to a



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type of digital media content, the functions being able to be performed during and after the digital media content is downloaded.

However, Lai teaches, in the same field of endeavor, a distributed on-demand media transcoding system and method, which performs processing functions on the digital media content which vary according to a type of digital media content, the functions being able to be performed during and after the digital media content is downloaded (fig. 5A; paragraphs [0141], [0158 - 0159], and [0188 - 0191]; Lai discloses the downloading may be fully performed prior to viewing or it may be progressive. That is a portion of the transcode media content may be downloaded and then viewed, while a second portion of the media content is being downloaded).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Bonomi by performing processing functions on the digital media content which vary according to a type of digital media content, the functions being able to be performed during and after the digital media content is downloaded as evidenced by Lai for the purpose permitting content providers to deliver media content to users with media players incapable of accommodating the source type of the original media content, thereby, obviating the need for a user to download a newer media player or upgrade an existing media player in order to access a desired media content.

Regarding claims 16 and 17, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, wherein the thin media client comprises an audio

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client; and wherein the digital media content comprises an audio file (col. 7, lines 33 - 62).

Regarding claim 18, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, wherein the digital media content comprises realtime audio information (col. 8, lines 35 - 54).

Regarding claims 19 and 20, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, wherein the thin media client comprises a video client, and wherein the digital media content comprises video information; and wherein the thin media client comprises an image client, and wherein the digital media content comprises image information (fig. 1B; col. 1, lines 30 – 36; col. 5, lines 32 – 40; col. 7, lines 33 – 50).

Regarding claim 21, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, which further comprises the step of transcoding the digital media content prior to providing the digital media content to the thin media client (305, fig. 3A; col. 6, lines 45 – 57; col. 11, lines 26 - 50).

Regarding claim 22, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, which further comprises the step of performing a rights management task associated with the digital media content prior to providing the digital media content to the thin media client (col. 15, lines 19 - 54).

Regarding claim 23, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, which further comprises the step of performing a decompression

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function on the digital media content prior to providing the digital media content to the thin media client (paragraph bridging col. 12, line 59 through col. 13, line 14).

Regarding claim 24, Bonomi and Lai teach all the limitations, and Bonomi further teaches a method, which further comprises the step of performing a decryption function on the digital media content prior to providing the digital media content to the thin media client (col. 14, lines 53 – 62; paragraph bridging col. 14, line 63 through col. 15, line 7).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt  
  
September 9, 2005

  
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